



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/439,095	05/11/1995	TOSHIMITSU MATSUI	40399/119	8286

36339 7590 06/05/2006

NATIONAL INSTITUTE OF HEALTH  
C/O NEEDLE & ROSENBERG, P.C.  
SUITE 1000  
999 PEACHTREE STREET  
ATLANTA, GA 30303

EXAMINER

MORAN, MARJORIE A

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 08/439,095	Applicant(s) MATSUI ET AL.	
	Examiner Marjorie A. Moran	Art Unit 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6, 22 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 22 and 25-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Sequence Requirements***

Applicant's arguments, filed 3/9/06, with regard to the sequence rules, are correct. In view of this, applicant is sincerely thanked for providing a CRF and otherwise complying with the current sequence rules, as it does facilitate full and complete search and examination of the claims. Claims 4-6, 22, and 25-36 are pending. Any objections and rejections set forth in previous office actions and not reiterated below are hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection.

Claim 34 recites a PDGFR protein having a species with molecular weight about 180-185 kD as determined by SDS- polyacrylamide gel, which is new matter. The original claims did not limit the weight of a protein. The originally filed specification, on pages 44 and 51, discloses proteins of 160 and 180 kD, or 180-200 and 165 kD, ALL

Art Unit: 1631

determined by Western blotting. Nowhere does the specification teach determining size ONLY by SDS-PAGE, nor does the specification teach any protein which is 180-185 kD. In the response filed 6/12/1998 (with the amendment to claim 34), applicant does not point to support for the newly added limitations. As the originally filed disclosure does not provide support for the new limitations of claim 34, the claim is rejected for reciting new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites "The cDNA pHF1" in line 1. However, the specification, on page 20, defines "pHF1" as a plasmid containing clone HF1. Claims 22 and 25 also recite plasmid "pHF1" and "PHF1", respectively. As pHF1 is defined and referred to as a plasmid everywhere but in claim 33, it is unclear what cDNA is actually intended in claim 33, therefore claim 33 is indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1631

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4-6, 22, 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by WILLIAMS et al. (US 6,372,438, filed 2/2/1988).

WILLIAMS teaches a protein of SEQ ID NO: 2, which is 100% identical to instant SEQ ID NO: 1, the deduced amino acid sequence shown in Figure 3, and thus anticipates claims 34-36. WILLIAMS also teaches SEQ ID NO: 1, which is 74.5% identical to instant SEQ ID NO: 2, the nucleotide sequence disclosed in Figure 3. WILLIAMS' SEQ ID NO: 1 would be expected to hybridize under stringent conditions to instant SEQ ID NO: 2, therefore claims 22, and 25-32 are anticipated. WILLIAMS teaches that his nucleotides may be cloned into expression vectors and that his polypeptides may be expressed in cells, and isolated (col. 2, lines 32-67), therefore claims 4-6 are also anticipated.

Claims 4-6, 22, 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by SLEDZIEWSKI et al. (US 5,567,584, filed 1/22/1988).

SLEDZIEWSKI teaches a protein of SEQ ID NO: 36, which is identical to instant SEQ ID NO: 1, thus anticipating claims 34-36. SLEDZIEWSKI also teaches a nucleotide sequence encoding his SEQ ID NO: 36, and teaches various portions of his amino acid sequence (Figures 11A and 1b and column 10, lines 26-40), thus anticipating claims 22 and 25-32. SLEDZIEWSKI further teaches that nucleotides may be

Art Unit: 1631

transformed into vectors and expressed in cells (col's 8-10), thereby anticipating claims 4-6.

**Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon-Fri, 6 am-2:30 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571)272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marjorie A. Moran  
Primary Examiner  
Art Unit 1631

*Marjorie A. Moran*  
5/30/06